

## **REMARKS:**

Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are currently pending in the Application.

Claims 2-4, 7-9, 11-13, 16-18, 20-22, and 25-27 have been previously canceled without *prejudice*.

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 101.

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 stand rejected under 35 § U.S.C. 103(a) over U.S. Patent No. 5,758,327 to Gardner *et al.* (“Gardner”) in view of U.S. Patent No. 7,117,165 B1 to Adams *et al.* (“Adams”).

The Applicants respectfully submit that all of the Applicants arguments and amendments are without *prejudice* or *disclaimer*. In addition, the Applicants have merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, the Applicants reserve the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. The Applicants further respectfully submit that by not responding to additional statements made by the Examiner, the Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by the Applicants are considered sufficient to overcome the Examiner's rejections. In addition, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

## **REJECTION UNDER 35 U.S.C. § 101:**

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Applicants respectfully disagree.

Nonetheless, the Applicants have amended independent Claims 1, 28, and 29 to more particularly point out and distinctly claim the Applicants invention. The Applicants respectfully submit that Claims 1-9, 28, and 29 are directed to patentable subject matter and are clearly directed to patentable subject matter. In addition, these amendments are not considered narrowing or necessary for patentability. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 101, as set forth in the Office Action.

For at least these reasons, the Applicant respectfully submits that Claims 1-9, 28, and 29 are directed to statutory subject matter. The Applicants further respectfully submit that Claims 1-9, 28, and 29 are in condition for allowance. Therefore, the Applicants respectfully request that the rejection of Claims 1-9, 28, and 29 under 35 U.S.C. § 101 be reconsidered and that Claims 1-9, 28, and 29 be allowed.

#### **REJECTION UNDER 35 U.S.C. § 112:**

Claims 1-9, 28, and 29 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Applicants respectfully disagree.

Nonetheless, the Applicants have amended independent Claims 1, 28, and 29 to more particularly point out and distinctly claim the Applicants invention. The Applicants respectfully submit that Claims 1-9, 28, and 29 are directed to patentable subject matter and are clearly directed to patentable subject matter. In addition, these amendments are not considered narrowing or necessary for patentability. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action.

The Applicants respectfully submit that Claims 1-9, 28, and 29 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further respectfully submit that Claims 1-9, 28, and 29 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-9, 28, and 29 under 35 U.S.C. § 112 be reconsidered and that Claims 1-9, 28, and 29 be allowed.

#### **REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 stand rejected under 35 § U.S.C. 103(a) over *Gardner* in view of *Adams*.

The Applicants respectfully submit that the ***amendments to independent Claims 1, 28, and 29 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims***. The Applicants further respectfully submit that amended independent Claims 1, 28, and 29 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Gardner* or *Adams*, either individually or in combination. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 under 35 U.S.C. § 103(a) over the proposed combination of *Gardner* and *Adams*, either individually or in combination.

#### **The Proposed *Gardner-Adams* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent Claim 1, this claim recites:

***A computer-implemented system for generating a request for quote (RFQ)***, comprising:

one or more computer systems comprising:

an ***RFQ engine comprising*** one or more components, wherein the one or more components are ***organized logically into one or more applications***, the RFQ engine comprising:

a ***data and metrics application***, the data and metrics application receives input from a user and generates a data and metrics model for an RFQ template using a data and metrics meta-model;

a **state transition application**, the state transition application receives input from the user and generates a state transition model for the RFQ template using a state transition meta-model;

a **workflow application**, the **workflow application receives** input from the user and **generates a user interface workflow** for the RFQ template using a workflow meta-model; and

an execution engine operable to execute the RFQ template comprising the data and metrics model generated by the data and metrics application, the state transition model generated by the state transition application, and the **user interface workflow generated by the workflow application**, the RFQ template being executed to generate an RFQ. (Emphasis Added).

In addition, *Gardner* and *Adams* fail to disclose each and every limitation of amended independent Claims 10, 19, and 28-31.

The Applicants respectfully submit that *Gardner* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “**computer-implemented system for generating a request for quote (RFQ)**” and in particular *Gardner* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**data and metrics application**, the data and metrics application receives input from a user and generates a data and metrics model for an RFQ template using a data and metrics meta-model”. In particular, it appears that the Examiner is equating the “**data and metrics application**” recited in amended independent Claim 1 with “**requisition rules**” disclosed in *Gardner*. (26 July 2007 Final Office Action, Page 4). However, **the requisition rules disclosed in Gardner** are merely procedures to be followed in the procurement of goods and services that *Gardner* describes as varying from company to company. (Column 1, Lines 12-21). The Applicants respectfully request clarification as to which varying **requisition rules** the Examiner is referring to and to what extent these varying **requisition rules** apply to the subject Application. In contrast, the “**data and metrics application**” recited in amended independent Claim 1 receives input from a user and generates a data and metrics model for an RFQ template using a data and metrics meta-model. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Gardner* and amended independent Claim 1 cannot be made. The

Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Gardner*.

The Applicants further respectfully submit that *Gardner* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**state transition application**”, the state transition application receives input from the user and generates a state transition model for the RFQ template using a state transition meta-model”. In particular, it appears that the Examiner is equating the “**state transition application**” recited in amended independent Claim 1 with the “**requisition rules**” disclosed in *Gardner*. (26 July 2007 Final Office Action, Pages 4-5). However, as discussed above, **the requisition rules disclosed in Gardner** are merely procedures to be followed in the procurement of goods and services and in particular, the **requisition rules** merely include an authorization matrix that dictates the individuals within the company (that is associated with the company specific requisition rules) that must sign in order to provide proper approval of the requisition, however, the **requisition rules disclosed in Gardner fail to include, involve, or even relate to the state transition application**, as recited in amended independent Claim 1. (Column 3, Lines 32-43). Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Gardner* and amended independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Gardner*.

### **The Office Action Acknowledges that *Gardner* Fails to Disclose Various Limitations Recited in Applicants Claims**

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that *Gardner* fails to disclose various limitations recited in amended independent Claim 1. Specifically the Examiner acknowledges that *Gardner* fails to teach “a workflow designer operable to generate, in response to input from the user, a user interface workflow for the RFQ template using a workflow meta-model”. (27 July 2007 Final Office Action, Page 5). However, the Examiner asserts that the cited portions of

*Adams* disclose the acknowledged shortcomings in *Gardner*. The Applicants respectfully traverse the Examiner's assertions regarding the subject matter disclosed in *Adams*.

The Applicants respectfully submit that *Adams* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding a “**computer-implemented system for generating a request for quote (RFQ)**” and in particular *Adams* fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding “a **workflow application, the workflow application receives** input from the user and **generates a user interface workflow** for the RFQ template using a workflow meta-model”. In particular, the Examiner equates the “**workflow**” recited in amended independent Claim 1 with the “**wizard**” disclosed in *Adams*. However, **the wizard disclosed in Adams** is merely a requisition wizard for employees who need to buy something, but **does not include, involve, or even relate to the workflow application**, as recited in amended independent Claim 1. (Column 3, Lines 9-56). In contrast, the “**workflow application**” recited in amended independent Claim 1 **receives** input from the user and **generates a user interface workflow** for the RFQ template using a workflow meta-model.

The Applicants further respectfully submit that because, as acknowledged by the Examiner, *Gardner* fails to teach “a workflow designer operable to generate, in response to input from the user, a user interface workflow for the RFQ template using a workflow meta-model”, *Gardner* likewise fails to teach an “execution engine operable to execute the RFQ template comprising [...] the **user interface workflow generated by the workflow application**, the RFQ template being executed to generate an RFQ”. In addition, the Examiner is silent as to how *Adams* overcomes the acknowledged shortcomings in *Gardner* with respect to amended independent Claim 1 limitations regarding “execution engine operable to execute the RFQ template comprising [...] the **user interface workflow generated by the workflow application**, the RFQ template being executed to generate an RFQ”. Thus, the Applicants respectfully submit that the equations forming the foundation of the Examiner's comparison between *Adams* and amended independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Adams*.

## **The Office Action Acknowledges that the Proposed *Gardner-Adams* Combination Fails to Disclose Various Limitations Recited in Applicants Claims**

The Applicants respectfully submit that the Office Action acknowledges, and the Applicants agree, that the proposed combination of *Gardner* and *Adams* fail to disclose various limitations recited in amended independent Claim 1. Specifically the Examiner acknowledges that the proposed combination of *Gardner* and *Adams* fail to teach “that the RFQ engine is logically organized into one or more tiers [applications]”. (27 July 2007 Final Office Action, Page 6). However, the Examiner appears to be asserting Official Notice over the acknowledged shortcomings in the proposed combination of *Gardner* and *Adams*. The Applicants respectfully traverse the Examiner’s taking of Official Notice.

### **The Examiner’s *Official-Notice* is improper under MPEP § 2144.03**

The Applicants respectfully submit that the Applicants are confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. The Applicants respectfully request clarification as to the subject matter for which Official Notice is being taken. ***The Applicants respectfully traverse the Official Notice because the asserted facts***, as best understood by the Applicants, ***are not supported by substantial documentary evidence or any type of documentary evidence*** and appear to be the Examiner’s opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner’s conclusion. (See MPEP § 2144.03). ***The Applicants respectfully request the Examiner to produce authority for the Examiners Official Notice.***

Only “in limited circumstances,” is it “appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection”. (MPEP § 2144.03). “Official notice unsupported by documentary evidence ***should only be taken by the examiner*** where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known.***

With respect to the subject Application, the Examiner's statement that the "it would have been obvious to one of ordinary skill in this art to modify the cited prior art to obtain the invention as specified in the claims", ***is not capable of instant and unquestionable demonstration as being well-known***. (27 July 2007 Final Office Action, Page 6). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is ***never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record***, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).



With respect to the subject Application, ***the Examiner has not properly Officially Noticed or not properly based the Official Notice on common knowledge.*** The Examiner's conclusory statement:

However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art ***to arrange the software applications of the cited prior art into tiers.*** Applicant has not disclosed that the tier organization provides an advantage, is used for a particular purpose or solves a stated problem. Furthermore, one of ordinary skill in the art would have ***expected Applicants' invention to perform equally well using any other arrangement because the functionality of a program is not dependent on how the program is logically organized.*** Therefore, it would have been obvious to one of ordinary skill in this art to modify the cited prior [sic] to obtain the invention as specified in the claims. (27 July 2007 Final Office Action, Page 6). (Emphasis Added).

The above noticed Examiner's conclusory statement ***does not adequately address the issue that this statement is considered to be common knowledge or well-known in the art.*** The Applicants respectfully submit the following statement, to further explain why the Examiner's above noticed statement is not considered to be common knowledge or well-known in the art.

***First***, it is not clear what the Examiner means by "it would have been obvious to one of ordinary skill in the art ***to arrange the software applications of the cited prior art into tiers***" (i.e. what ***arrangement*** is the Examiner referring to and to what extent does the Examiner purport this ***arranging of the software applications*** applies to the subject Application). In fact, the limitations recited in amended independent claim 1 are directed to an "***RFQ engine comprising*** one or more components, wherein the one or more components are ***organized logically into one or more applications***". It is not clear how the Examiner's purported "***arrange the software applications***" relates to the "***RFQ engine comprising*** one or more components, wherein the one or more components are ***organized logically into one or more applications***".

***Second***, it is not clear what the Examiner means by "one of ordinary skill in the art would have ***expected Applicants' invention to perform equally well using any other arrangement because the functionality of a program is not dependent on how the***

***program is logically organized*** (i.e. what “***equally well***” or what “***any other arrangement***” is the Examiner referring to and how is this “***expect[ation]***” related to the subject Application). In addition, it is not clear what the Examiner means by “***the functionality of a program is not dependent on how the program is logically organized***”, what “***program***” is the Examiner referring to what “***dependen[ce]***” is the Examiner referring to. ***The Applicants respectfully disagree and further respectfully request clarification as to how the Examiner arrives at this conclusion.***

***Third***, as explained above, the Examiner’s statement that “, it would have been obvious to one of ordinary skill in the art ***to arrange the software applications of the cited prior art into tiers***” and “one of ordinary skill in the art would have ***expected Applicants’ invention to perform equally well using any other arrangement because the functionality of a program is not dependent on how the program is logically organized***” are not considered to be common knowledge or well-known in the art. The Applicants respectfully submit that “***RFQ engine***” recited in amended independent claim 1 also provides for “components” that are “***organized logically into one or more applications***”. Thus, the Applicants further submit that the equations forming the foundation of the Examiner’s comparison between the Examiner’s purported Official Notice and amended independent claim 1 cannot be made.

***Fourth***, there is simply no disclosure, teaching, or suggestion in the proposed combination of *Gardner, Adams*, or the Examiner’s Official Notice of an “***RFQ engine comprising*** one or more components, wherein the one or more components are ***organized logically into one or more applications***”.

The Applicants respectfully submit that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. ***The Applicants respectfully request the Examiner to produce authority for the Examiner’s statement “that a seller would automatically determine best cost of each item”, is old and well known.***

The Applicants further submit that ***the Applicants have adequately traversed the Examiner's assertion of Official Notice*** and direct the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 based on the Official Notice, ***the Applicants respectfully request that the Examiner provide documentary evidence*** as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, ***the Applicants further request that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding*** as further necessitated by MPEP § 2144.03(C).

#### **The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Gardner-Adams* Combination According to the UPSTO Examination Guidelines**

The Applicants respectfully submit that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Gardner* or *Adams*, either individually or in combination, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the “Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*” (the “Guidelines”).

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103

is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, “While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel “**ensure that the written record includes findings of fact** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the “**factual findings made by Office personnel are the necessary underpinnings to establish obviousness.**” (*id.*). Further, “**Office personnel must provide an explanation to support an obviousness rejection** under 35 U.S.C. 103. (*id.*). In fact, “35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (*id.*).

With respect to the subject application, the Office Action has not shown the **factual findings necessary to establish obviousness** or even **an explanation to support the obviousness rejection** based on the proposed combination of *Gardner* and *Adams*. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the wizard of *Adams* into the invention of *Gardner*”. (26 July 2007 Final Office Action, Page 5). The Applicants

respectfully disagree and respectfully submit that the Examiner's conclusory statement is not sufficient to establish the ***factual findings necessary to establish obviousness*** and is not a sufficient ***explanation to support the obviousness rejection*** based on the proposed combination of *Gardner* and *Adams*.

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any ***“obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill.”*** (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has not provided ***an indication of the level of ordinary skill***.

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is ***whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.*** (*Id.* and See 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicants invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the difference(s) between the proposed combination of Gardner and Adams and the Applicants claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that “one of ordinary skill in the

art would have been motivated to do so in order to guide a user through a series of questions at each step, providing navigational aids to keep track of the big picture, and presenting lists of choices whenever possible instead of asking the employee to type things in, as taught by *Adams*.” (26 July 2007 Final Office Action, Pages 5-6). The Applicants respectfully disagree and further respectfully request clarification as to how this statement ***explains why the difference(s) between the proposed combination of Gardner and Adams and the Applicants claimed invention would have been obvious to one of ordinary skill in the art.*** The Applicants further respectfully submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the “key to supporting any rejection under 35 U.S.C. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that “***the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.***” (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that “[R]ejections on ***obviousness cannot be sustained by mere conclusory statements***; instead, there ***must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.***” (*KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

The Applicants respectfully submit that the ***Office Action fails to provide any articulation, let alone, clear articulation of the reasons why the Applicants claimed invention would have been obvious.*** For example, the ***Examiner has not adequately supported the selection and combination of Gardner and Adams to render obvious the Applicants claimed invention.*** The Examiner's unsupported conclusory statements that "it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the wizard of *Adams* into the invention of *Gardner*" and that "one of ordinary skill in the art would have been motivated to do so in order to guide a user through a series of questions at each step, providing navigational aids to keep track of the big picture, and presenting lists of choices whenever possible instead of asking the employee to type things in, as taught by *Adams*", ***does not adequately provide clear articulation of the reasons why the Applicants claimed invention would have been obvious.*** (26 July 2007 Final Office Action, Pages 5-6). In addition, ***the Examiner's unsupported conclusory statement fails to meet any of the Guidelines rationales to render obvious the Applicants claimed invention.***

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Gardner* and *Adams*, the Applicants respectfully request that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines.

### **The Applicants Claims are Patentable over the Proposed *Gardner-Adams* Combination**

The Applicants respectfully submit that amended independent Claim 1 is considered patentably distinguishable over the proposed combination of *Gardner* and *Adams*. This being the case, amended independent Claims 10, 19, and 28-31 are also considered patentably distinguishable over the proposed combination of *Gardner* and

*Adams*, for at least the reasons discussed above in connection with amended independent Claim 1.

Furthermore, with respect to dependent Claims 5, 6, 14, 15, 23, and 24: Claims 5 and 6 depend from amended independent Claim 1; Claims 14 and 15 depend from amended independent Claim 10; and Claims 23 and 24 depend from amended independent Claim 19. As mentioned above, each of amended independent Claims 1, 10, 19, and 28-31 are considered patentably distinguishable over *Gardner* and *Adams*. Thus, dependent Claims 5, 6, 14, 15, 23, and 24 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants respectfully submit that Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are not rendered obvious by the proposed combination of *Gardner* and *Adams*. The Applicants further respectfully submit that Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1, 5, 6, 10, 14, 15, 19, 23, 24, and 28-31 be allowed.

#### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C.



§ 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

## **CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

A Request for Continued Examination (RCE) is being filed electronically herewith to facilitate the processing of this deposit account authorization. **The Director is hereby authorized to charge the \$810.00 RCE fee and the \$120.00 One-Month Extension of Time Fee to Deposit Account No. 500777.** Although the Applicants believe no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777.** If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777.**

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

21 November 2007  
Date

/Steven J. Laureanti/signed  
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